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| 10/826,866      | 04/16/2004  | Ricardo Alexander Gomez | 5285-0001           | 1442             |

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EXAMINER

KASZTEJNA, MATTHEW JOHN

ART UNIT PAPER NUMBER

3739

DATE MAILED: 08/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/826,866

Applicant(s)

GOMEZ, RICARDO ALEXANDER

Examiner

Matthew J. Kasztejna

Art Unit

3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6, 8-18 and 20-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-18 and 20-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 August 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Notice of Amendment***

In response to the amendment filed on May 9, 2006, amended claims 6, 8-18, 20-26 and canceled claims 7 and 19 are acknowledged. The current rejections of the claims under 35 U.S.C. 112 2<sup>nd</sup> paragraph are withdrawn. The following new and reiterated grounds of rejection are set forth:

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4 and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Beane et al. (U.S. Patent Application Publication No. 2002/0022762).

**In regards to claims 1-4 and 26**, Beane et al. teach a warming and cleaning device 110 for a laparoscope 10 comprised of a housing 112, a heat-conducting tube 114, a sponge 116, a container or bottle 118 and a heating element, such as a heating pad 120 (see Figures 2A to 5F). Bottle 18 is filled with a solution that can contain an antifogging solution and when the surgeon squeezes bottle 118, the bottle dispenses the solution to moisten sponge 116 (see page 3, section 0056). The heating pad 120 includes an outer pad 146 that encases a chemical mixture that, when activated, generates an exothermic reaction (see page 3, section 0057). Pad 120 is wrapped around the tube 114 inside of housing 12 (see Figure 2A). In operation, the distal

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portion 16 of laparoscope 10 is inserted through opening 240 until the lens portion 14 abuts sponge 216, so that the lens portion 14 is cleaned and defogged and the laparoscope 10 is warmed (see page 4, section 0070). The housing 112 can be made from a hard plastic, which would make is shock absorbent (see page 4, section 0061). A wiping compartment 312 is provided in an alternate embodiment and a hook and loop assembly 180 can be used to attach the device to an operating table (see page 4, section 0066).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5-6, 8-18 and 20-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beane et al. (U.S. Patent Application Publication No. 2002/0022762) in view of U.S. Patent No. 5,351,675 to Brodsky.

**In regards to claims 5-6, 8-18 and 20-25,** Beane et al. teach a warming and cleaning device 110 for a laparoscope 10 comprised of a housing 112, a heat-conducting tube 114, a sponge 116, a container or bottle 118 and a heating element, such as a heating pad 120 (see Figures 2A to 5F). Bottle 18 is filled with a solution that can contain an antifogging solution and when the surgeon squeezes bottle 118, the bottle dispenses the solution to moisten sponge 116 (see page 3, section 0056). The heating pad 120 includes an outer pad 146 that encases a chemical mixture that, when

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activated, generates an exothermic reaction (see page 3, section 0057). Pad 120 is wrapped around the tube 114 inside of housing 12 (see Figure 2A). In operation, the distal portion 16 of laparoscope 10 is inserted through opening 240 until the lens portion 14 abuts sponge 216, so that the lens portion 14 is cleaned and defogged and the laparoscope 10 is warmed (see page 4, section 0070). The housing 112 can be made from a hard plastic, which would make is shock absorbent (see page 4, section 0061). A wiping compartment 312 is provided in an alternate embodiment and a hook and loop assembly 180 can be used to attach the device to an operating table (see page 4, section 0066). Beane et al. are silent with respect to wherein the apparatus includes breachable membranes separating chambers containing reactants configured such that when the membranes are breached permit the reactants to mix and generate a sustained exothermic reaction for heating a defogging solution and a scope when submerged in the defogging solution. However, Beane et al. teach that other types of heating elements can replace heating pad 120 (see paragraph 0067). Brodsky teaches of an analogous apparatus wherein the apparatus comprises a casing which is adapted for receiving the shaft portion of an optical instrument therein and heater means in the casing for heating the shaft portion to a temperature which is at least equal to the normal body temperature of a patient. The heater means preferably comprises means which is actuatable for producing an exothermic chemical reaction in order to heat the instrument. Specifically, the means for producing an exothermic chemical reaction preferably comprises of flexible bag in the casing containing a first chemical and a rupturable member containing a second chemical. The rupturable member is rupturable

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for introducing the second chemical into the first chemical in order to produce an exothermic chemical reaction, and it is rupturable from the exterior of the casing. The first and second chemicals preferably comprise water and magnesium sulfate, respectively, and the casing preferably comprises a elongated sheath having an open end for receiving the shaft portion of an instrument therein (see Col. 2, Lines 1-57). It would have been obvious to one skilled in the art at the time the invention was made to include a heating element with breachable membranes in the apparatus of Beane et al. to provide an alternate heating element not requiring exposure to oxygen to undergo an exothermic reaction as taught by Brodsky.

### ***Response to Arguments***

Applicant's arguments filed May 9, 2006 have been fully considered but they are not persuasive.

Applicant states that Beane et al. does not teach or suggest a self-sealing mechanism disposed within the canal, the self-sealing mechanism and configured to allow for an endoscope to enter the canal and make contact with the defogging material and to prevent the defogging material from spilling out of the canal. However, Beane et al. disclose the device wherein the distal end 124 is attached to bottle 118, and proximal end 122 is attached to a stem 126 on housing 112. Distal end attaches to bottle 118 via complementary screw threadings 128 (inside tube 114) and 130 (on bottle 118). Alternatively, bottle 118 and distal end 124 can be attached by an interference or press fit, using, e.g., an O-ring. Proximal end 122 is similarly attached to stem 126 using, e.g., complementary screw threadings, an insert mold, or an interference fit (see paragraph

0053). The interference or press fitting is configured to allow the endoscope to enter the canal and make contact with the defogging material and further prevents spillage of the material out of the canal, thus meeting the limitations of claim 1.

Applicant states that Beane et al. does not teach or suggest an apparatus including a fluid disposed within a hollow receptacle or reservoir configured for allowing an instrument to be submerged and heated via the fluid. However, Beane et al. disclose a hollow receptacle 114 for receiving an instrument. The instrument is further heated via the heating element 120 which can surround the cleaning member 116, and thus as broadly as claimed the instrument is being heated via the fluid which is disposed within a hollow receptacle (see Fig.2a and paragraph 0019 and 0056).

Furthermore, the combination of Beane et al. and Brodsky applied in new rejections with regards to claims 5, 16-18 and 20-25 clearly disclose an apparatus including a fluid disposed within a hollow receptacle or reservoir configured for allowing an instrument to be submerged and heated via the fluid (see Col. 2, Lines 1-57 and Figs. 1-2 of Brodsky).

Applicant's arguments with respect to claims 5, 16-18 and 20-25 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

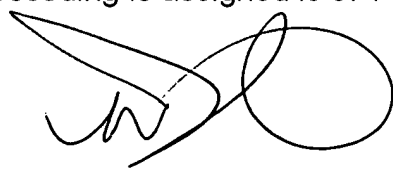
Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew J. Kasztejna whose telephone number is (571) 272-6086. The examiner can normally be reached on Mon-Fri, 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



LINDA C. M. DVORAK  
SUPERVISORY PATENT EXAMINER  
GROUP 3700



Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MJK



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